

Remarks

Claims 1-53 are pending in the present application. By this amendment, claims 13, 19, 28, 30, 31, 40, 42, and 48-50 are amended. Reconsideration is requested in view of the amendments and the following remarks.

I. Objections to Claims 28, 36, 42, and 48

Claims 28, 42, and 48 have been amended to address the objection to these claims. No changes to claim 36 are believed to be required since the phrase “for adhering to skin” does not render the claim unclear.

II. Rejection of Claims 30 and 31

Claims 30 and 31 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,331,691 to Runckel (Runckel). Applicants traverse this rejection and request that it be withdrawn.

Claim 30 has been amended to specify that the flange has an upper and lower portion, and the posterior surface of the flange upper portion and the posterior surface of the lens define a minimum depth that is less than 8 mm, and the posterior surface of the flange lower portion and the posterior surface of the lens define a minimum depth that is less than 8 mm. Thus, in the instantly claimed invention, the eyepiece has a minimum depth of less than 8 mm at the upper and lower portions of the flange.

In Runckel, the upper wall 16 of the eyepiece has a width (depth) 51 of 0.11 inch (2.794 mm) (FIG. 3a) and the lower wall 18 of the eyepiece has a width (depth) 52 of .45 inch (11.43 mm) (FIG. 3b). Applicants note that the dimensions given in Runckel for the upper and lower walls 16, 18 are measured from the anterior surface of the lens and do not include the width of the rim 40, and therefore do not represent the overall minimum depth of the eyepiece measured from the posterior surface of the lens, as recited in claim 30. Although Runckel does not disclose the actual minimum depth of the eyepiece (as defined in the specification and claim 30), it would appear that the depth of the lower wall 18 from the posterior surface of the lens 14 to the posterior surface of the rim 40 would be at least 11.43 mm, and therefore would not satisfy the dimensions recited in claim 30.

Accordingly, claim 30 is not anticipated or rendered obvious by Runckel, and therefore is allowable.

Claim 31 depends from claim 30 and is allowable for at least the reasons discussed above in support of claim 30 and because claim 31 sets forth an independently patentable combination of features.

III. Rejection of Claims 40, 42-43, 46-48, and 50-51

Claims 40, 42-43, 46-48, and 50-51 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,896,588 to Chiang (Chiang). Applicants traverse this rejection and request that it be withdrawn.

Claims 40, 42-43, and 46-47:

Claim 40 has been amended to specify that the side lens of each eyepiece intersects a respective anterior lens at a line extending between opposing points on the periphery of the side lens defining a maximum width of the side lens in the superior-inferior direction. In other words, in the instantly claimed invention, the vertical edge at the intersection of the side lens and the anterior lens defines the maximum width of the side lens (see side lens 22 in FIG. 5 of the application).

Unlike the instantly claimed invention, the '588 patent to Chiang discloses an eyepiece having an elliptical anterior lens 12 and an elliptical side lens 121 that intersects the anterior lens at one end thereof (see FIG. 3 of the '588 patent). The maximum width of the side lens 121 in the superior-inferior direction is measured along a vertical line spaced temporally from the intersection of the side lens 121 and the anterior lens 12 (at about the middle of the side lens 121).

Accordingly, claim 40 as amended is not anticipated or rendered obvious by the '588 patent, and therefore is allowable.

Claims 42-43 and 46-47 depend from claim 40 and are allowable for at least the reasons discussed above in support of claim 40 and because each dependent claim sets forth an independently patentable combination of features.

Claim 48:

Claim 48 has been amended to recite the subject matter previously recited in claim 49. Thus, claim 48 now recites two annular, transparent side walls, each side wall connected at one end to a respective frame portion and at another end to a respective anterior lens and side lens. Claim 48 further specifies that each side wall curves continuously and completely around a respective anterior lens and side lens.

Since original claim 49 was not rejected as being anticipated by the '588 patent to Chiang, the 102(b) rejection of claim 48 should be withdrawn. Furthermore, Chiang also fails to teach or suggest the feature of a side wall that curves continuously and completely around an anterior lens and a side lens.

Claims 50 and 51:

Claim 50 has been amended to recite that the lens has an outer peripheral edge that extends around the anterior lens and the side lens, with the peripheral edge tapering from the intersection of the anterior lens and the side lens to the temporal end of the lens.

The eyepieces disclosed in the '588 patent to Chiang each includes an elliptical anterior lens 12 intersecting an elliptical side lens 121 at adjacent ends (see FIG. 3 of the '588 patent). In contrast to the instantly claimed invention, the periphery of the side lens initially widens from the intersection of the side lens and the anterior lens before it begins to taper in the temporal direction.

Accordingly, claim 50 as amended is not anticipated or rendered obvious by the '588 patent, and therefore is allowable.

Claim 51 depends from claim 50 and is allowable for at least the reasons discussed above in support of claim 50 and because claim 51 sets forth an independently patentable combination of features.

IV. Rejection of Claims 1-6, 26, 28-29, and 52-53

Claims 1-6, 26, 28-29, and 52-53 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Runckel in view of U.S. Patent No. 6,131,208 to Banks (Banks). Applicants traverse this rejection and request that it be withdrawn.

Claims 1-6:

Claim 1 recites an eyepiece for swim goggles comprising a protective body adapted to be worn over an eye of a user, the body comprising a transparent lens portion and a frame portion surrounding the lens portion wherein the frame portion is shaped to generally conform to the shape of the orbital rim. Claim 1 also includes an adhesive layer that adhesively secures the body to the skin of the user in close proximity to the eye so as to form a substantially water-tight seal around the eye that substantially isolates the eye from the surrounding environment during use.

The Office action concedes that Runckel does not disclose adhesive tape for securing an eyepiece to the skin of a user. However, the action contends “it would have been obvious . . . to modify Runckel’s apparatus by replacing the strap with a double-sided adhesive tape as taught by Banks since the adhesive tape is an effective alternative to the strap in serving the function of attaching the body to the face and subsequently creating a water-tight seal..” In reply, Applicants submit that this contention does not support any combination of Runckel and Banks to derive the subject matter recited in claim 1.

The test for obviousness is not whether an element from a primary reference can be replaced with another element from a secondary reference, or whether the element in the secondary reference is a suitable alternative to the element in the primary reference. *Winner International Royal Corp. v. Wang*, 202 F.3d 1340 (Fed. Cir. 2000). Rather, the correct test for determining obviousness, as provided in MPEP § 2143.01, is whether the prior art suggests the desirability of replacing a component from one reference with a different component from another reference. Stated differently, there must be some teaching or motivation in the prior art for combining the teachings of the prior art. In the *Winner* case, the Federal Circuit rejected the accused infringer’s argument that two prior art references should be combinable because both references were in the same field (steering wheel locks) as the invention. The Federal Circuit held that the fact that it was feasible to replace the deadbolt lock of the primary reference with a self-locking ratcheting mechanism of the secondary reference was insufficient to provide the motivation to combine the references.

Similarly, the fact that adhesive tape is an effective alternative to straps for securing swim goggles to the face of a user and creating a water-tight seal (which is taught by Applicants’ disclosure, not Runckel or Banks), does not, by itself provide any motivation to combine the references. It is known that conventional swim goggles with straps, such as disclosed in

Runckel, are effective to create a water-tight seal around the eyes of the wearer. If Runckel can already achieve this objective, then one skilled in the art would not have been motivated to replace the straps with an alternative securing mechanism unless that mechanism provided some advantage or cured some deficiency of the straps. The action does not identify any such advantage or motivation for using something other than straps in swim goggles. Accordingly, a *prima facie* case of obviousness of claim 1 has not been established, and thus, the rejection must be withdrawn.

In addition, Banks concerns an eye protector 1 that is used to cover the eye of a person using a sun lamp, sunbed, tanning bed, or other skin tanning apparatus. The reason for using adhesive tape rather than an elastic head strap and nose bridge with Banks' eyepiece is to avoid the problem of areas around the eyes remaining untanned after using a tanning bed, which can look strange and undesirable. Col. 1, lines 10-17. On the other hand, Applicants' device provides a significant improvement over conventional goggles with straps in that it is effective to create water-tight seal around the eyes in an underwater environment while also reducing hydrodynamic drag by eliminating the strap. Neither Banks nor Chiang recognizes that hydrodynamic drag can be reduced by using an adhesive instead of straps for securing swim goggles to the face of a swimmer. Hence, these references lack any motivation to combine their teachings in the manner suggested by the action.

The Office action further contends that since Runckel discloses the use of a strap, it therefore implies that other techniques can be used to secure the goggles to the face of a user. Applicants disagree. As best shown in FIG. 4, Runckel discloses swim goggles comprising a left eyepiece 12 and a right eyepiece 12a. Each eyepiece 12, 12a has a respective strap support flange 25, 25a for securing a head strap 24 (FIG. 1). As shown in FIGS. 1 and 4, the support flanges 25, 25a extend upwardly from the eyepieces 12, 12a to orient the strap in an upwardly pulling position so that each eyepiece is urged up against the inner side of the supra-orbital border creating a more comfortable and efficient goggle design. Col. 3, lines 13-19 and col. 5, lines 16-21. There is no hint or suggestion in Runckel that other techniques can be used to secure the eyepieces to the face of the wearer, let alone other techniques that can achieve the desired positioning for the eyepieces.

Furthermore, there is no suggestion to combine or modify a prior art reference if the reference teaches away from making the specific combination of elements recited in a claim. *See*

Tec Air, Inc. v. Denso Mfg. Mich. Inc., 192 F.3d 1353, 1360, 52 U.S.P.Q. 2d 1294, 1298 (Fed. Cir. 1999). Runckel teaches away from a strapless design because a user could not achieve the desired positioning for Runckel's eyepiece without the use of a head strap. In other words, the use of adhesive tape instead of the strap 24 would not be effective to pull the eyepieces 12, 12a upwardly against the inner side of the supra-orbital border. Thus, a skilled person would not have been motivated to replace Runckel's head strap 24 with an alternative means for securing the eyepieces to the face of a user.

Accordingly, for the foregoing reasons, claim 1 is not rendered obvious by Runckel in view of Banks and is allowable.

Claims 2-5 depend from claim 1 and are allowable for the reasons given above in support of claim 1 and because each dependent claim sets forth an independently patentable combination of features.

Claims 26, 28 and 29:

Claim 26 recites an eyepiece for swim goggles comprising a body that comprises a transparent lens and a peripheral flange surrounding the lens, wherein the flange has a posterior surface, and an adhesive layer mounted on the posterior surface of the flange. Neither Runckel nor Banks (either alone or in combination) teaches or suggests the instantly claimed swim goggles.

Contrary to the Examiner's contention, neither Runckel nor Banks recognizes that tape can be used as a suitable alternative to a head strap for adequately securing swim goggles to the face of a swimmer during use. Even if this were true, the fact that tape can be used as a suitable alternative to a head strap in swim goggles (which is taught by Applicants, not Runckel or Banks) does not, by itself, provide any motivation to combine the reference teachings, and therefore does not establish a *prima facie* case of obviousness of claim 26.

Additionally, Banks concerns an eye protector 1 that is used to cover the eye of a person using a sun lamp, sunbed, tanning bed, or other skin tanning apparatus. The reason for using adhesive tape rather than an elastic head strap and nose bridge with Banks' eyepiece is to avoid the problem of areas around the eyes remaining untanned after using a tanning bed, which can look strange and undesirable. Col. 1, lines 10-17. On the other hand, Applicants' device provides a significant improvement over conventional goggles with straps in that it is effective to create water-tight seal around the eyes in an underwater environment while also reducing

hydrodynamic drag by eliminating the strap. Neither Banks nor Chiang recognizes that hydrodynamic drag can be reduced by using an adhesive instead of straps for securing swim goggles to the face of a swimmer. Hence, these references lack any motivation to combine their teachings in the manner suggested by the action.

Finally, Runckel employs support flanges 25, 25a that extend upwardly from the eyepieces 12, 12a to orient the strap in an upwardly pulling position so that each eyepiece is urged up against the inner side of the supra-orbital border. Runckel teaches away from the proposed combination because it would be impossible to achieve the desired positioning for the eyepieces, as taught by Runckel, without the use of a head strap. Thus, there is no motivation to combine Runckel and Banks.

For the foregoing reasons, claim 26 is not obvious from Runckel in view of Banks and is allowable.

Claims 28 and 29 depend from claim 26 and are allowable for the reasons given above in support of claim 26 and because each dependent claim sets forth an independently patentable combination of features.

Claim 52:

Claim 52 recites, *inter alia*, a pair of eyepieces adapted to be worn over the eyes of a user, each eyepiece having a posterior surface, and at least two pieces of double-sided adhesive tape that are shaped to be applied to the posterior surfaces of the eyepieces so that the tape can be used to adhesively secure the eyepieces to the skin of the user.

In view of certain similarities between claim 1 and claim 52, claim 52 is allowable over Runckel and Banks for the reasons given above in regards to claim 1.

Claim 53:

Claim 53 recites an eyepiece comprising a body comprising a transparent lens and a peripheral flange surrounding the lens, the flange having a posterior surface, and an adhesive layer mounted on the posterior surface of the flange and having an adhesive surface that adhesively secures the body to the skin of the user in close proximity to the eye so as to substantially isolate the eye from the surrounding environment during use.

In view of certain similarities between claim 1 and claim 53, claim 53 is allowable over Runckel and Banks for the reasons given above in regards to claim 1.

V. Rejection of Claims 7-9, 15-16, 20, 22, and 24

Claims 7-9, 15-16, 20, 22, and 24 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious from U.S. Patent No. 6,574,802 to Chiang (Chiang) in view of Banks. Applicants traverse this rejection and request that it be withdrawn.

Claims 7-9 and 15-16:

Claim 7 recites swim goggles comprising a pair of unconnected eyepieces, each eyepiece adapted to provide a water-tight seal around an eye of a user during use of the goggles. The eyepieces are without any straps extending around the rear of the user's head and securing the eyepieces to the user's face in an as worn orientation. Neither Chiang nor Banks teaches or suggests the instantly claimed invention.

In the rejection of claim 7, the action states: "It would have been obvious to one having ordinary skill in the art . . . to modify Chiang's apparatus by replacing the straps with an adhesive tape as taught by Banks in order to provide an alternative means of attaching the goggles to the skin of the user while still allowing for the independent adjustability of each eyepiece." Applicants disagree.

As discussed above, the test for obviousness is not whether two or more prior references can be combined, but whether the prior art suggests the desirability of the claimed invention. MPEP § 2143.01. As acknowledged in the action, an object of Chiang is to provide swim goggles that have independently adjustable eyepieces (through the use of separate straps for each eyepiece). If Chiang can already achieve this objective, then one skilled in the art would not have been motivated to seek Banks or to replace the straps with an alternative securing mechanism unless that mechanism provided some advantage or cured some deficiency of the straps. The action does not identify any such advantage or motivation for using something other than straps in swim goggles. Accordingly, a *prima facie* case of obviousness of claim 7 has not been established, and thus, the rejection must be withdrawn.

The action further states that "Chiang never states that [the] objective [of the invention] cannot be achieved without the use of straps." In reply, Applicants note that the absence of any mention of strapless goggles only reinforces that there is no teaching or motivation to use something other than straps to secure Chiang's goggles to the face of a user.

Banks does not make up for the deficiencies of Chiang. Banks concerns an eye protector 1 that is used to cover the eye of a person using a sun lamp, sunbed, tanning bed, or other skin

tanning apparatus. The reason for using adhesive tape rather than an elastic head strap and nose bridge with Banks' eyepiece is to avoid the problem of areas around the eyes remaining untanned after using a tanning bed, which can look strange and undesirable. Col. 1, lines 10-17. On the other hand, Applicants' device provides a significant improvement over conventional goggles with straps in that it is effective to create water-tight seal around the eyes in an underwater environment while also reducing hydrodynamic drag by eliminating the strap. Neither Banks nor Chiang recognizes that hydrodynamic drag can be reduced by using an adhesive instead of straps for securing swim goggles to the face of a swimmer. Hence, these references lack any motivation to combine their teachings in the manner suggested by the action.

Claims 8, 9, 15, and 16:

Claims 8, 9, 15, and 16 depend from claim 7 and are allowable for the reasons given above in support of claim 7 and because each dependent claim sets forth an independently patentable combination of features.

Claims 20, 22, and 24:

Claim 20 recites a method of using strapless swim goggles comprising a pair of unconnected eyepieces. The method comprises securing the eyepieces to a user's face adjacent the eyes without the aid of a strap extending around the user's head.

In view of certain similarities between claim 20 and claim 7, claim 20 is allowable over Chiang and Banks for the reasons given above in regards to claim 7.

Claims 22 and 24 depend from claim 20 and are allowable for the reasons given above in support of claim 20 and because each dependent claim sets forth an independently patentable combination of features.

VI. Rejection of Claims 10-12, 17, 21, 23, and 25

Claims 10-12, 17, 21, 23, and 25 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious from the '802 patent to Chiang in view of Banks and Runckel. Applicants traverse this rejection and request that it be withdrawn.

Claims 10-12 and 17 depend from claim 7 and are allowable for the reasons given above in support of claim 7 and because each dependent claim sets forth an independently patentable combination of features.

Claims 21, 23 and 25 depend from claim 20 and are allowable for the reasons given above in support of claim 20 and because each dependent claim sets forth an independently patentable combination of features.

VII. Rejection of Claims 13 and 14

Claims 13 and 14 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious from the '802 patent to Chiang in view of Runckel. Applicants traverse this rejection and request that it be withdrawn.

Claim 13 recites swim goggles comprising a pair of unconnected eyepieces, each eyepiece adapted to provide a water-tight seal around an eye of a user during use of the goggles. Claim 13 has been amended to recite that each eyepiece has a minimum depth of less than 8 mm measured at locations above and below the eyes when the eyepieces are in an as worn orientation (added language underlined).

In Runckel, the upper wall 16 of the eyepiece has a width (depth) 51 of 0.11 inch (2.794 mm) (FIG. 3a) and the lower wall 18 of the eyepiece has a width (depth) 52 of .45 inch (11.43 mm) (FIG. 3b). Applicants note that the dimensions given in Runckel for the upper and lower walls 16, 18 are measured from the anterior surface of the lens and do not include the width of the rim 40, and therefore do not represent the overall minimum depth of the eyepiece (as defined in the present application). Although Runckel does not disclose the actual minimum depth of the eyepiece, it would appear that the depth of the lower wall 18 from the posterior surface of the lens 14 to the posterior surface of the rim 40 would be at least 11.43 mm, and therefore would not satisfy the dimensions recited in claim 13.

Accordingly, claim 13 is not rendered obvious by Chiang and Runckel, and therefore is allowable.

Claim 14 depends from claim 13 and is allowable for at least the reasons discussed above in support of claim 13 and because claim 14 sets forth an independently patentable combination of features.

VIII. Rejection of Claims 18 and 19

Claims 18 and 19 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious from the '802 patent to Chiang in view of Banks and the '588 patent to Chiang. Applicants traverse this rejection and request that it be withdrawn.

Claims 18 and 19 depend from claim 7 and are allowable for the reasons given above in support of claim 7 and because each dependent claim sets forth an independently patentable combination of features.

For example, claim 19, in combination with claim 18, recites that each eyepiece comprises an annular peripheral wall that surrounds a respective anterior lens portion and side lens portion and extends rearwardly therefrom. Claim 19 has been amended to further recite that the side lens portion of each eyepiece intersects a respective anterior lens portion at a line extending between opposing points on the periphery of the side lens portion defining a maximum width of the side lens portion in the superior-inferior direction.

In contrast to claim 19, the '588 patent to Chiang discloses goggles in which each side lens 121 intersects an anterior lens 12 at a tapered end of the side lens 121. Thus, in this configuration, the maximum width of the side lens 121 in the superior-inferior direction is at about the center of the side lens 121, not at the intersection with the anterior lens (as recited in claim 19).

IX. Rejection of Claim 27

Claim 27 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious from Runckel in view of Banks and the '588 patent to Chiang. Applicants traverse this rejection and request that it be withdrawn.

Claim 27 depends from claim 26 and is allowable for at least the reasons discussed above in support of claim 26 and because claim 27 sets forth an independently patentable combination of features.

X. Rejection of Claim 32

Claim 32 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious from the '802 patent to Chiang in view of Runckel and Banks. Applicants traverse this rejection and request that it be withdrawn.

Claim 32 recites swim goggles comprising, *inter alia*, a pair of unconnected eyepieces, each eyepiece adapted to provide a water-tight seal around an eye of a user during use of the goggles. Each eyepiece comprises a transparent lens portion and a frame portion surrounding the lens portion. A layer of adhesive tape is secured to frame portion of each eyepiece and has an adhesive surface for adhering to the skin adjacent the eye. Neither the Chiang '802 patent, Runckel, nor Banks (alone or in combination) teaches or suggests the instantly claimed invention.

The action contends that "it would have been obvious . . . to modify Runckel's apparatus by replacing the strap with a double-sided adhesive tape as taught by Banks since the adhesive tape is an effective alternative to the strap in serving the function of attaching the body to the face and subsequently creating a water-tight seal." Applicants disagree with this contention.

The test for obviousness is not whether an element in a secondary reference is a suitable alternative to another element in a primary reference. Rather, the correct test for determining obviousness, as provided in MPEP § 2143.01, is whether the prior art suggests the desirability of replacing a component from one reference with a different component from another reference.

The fact that adhesive tape is an effective alternative to straps for securing swim goggles to the face of a user and creating a water-tight seal (which is taught by Applicants' disclosure, not Runckel or Banks), does not, by itself provide any motivation to combine the references. It is known that conventional swim goggles with straps, such as disclosed in Runckel, are effective to create a water-tight seal around the eyes of the wearer. If Runckel can already achieve this objective, then one skilled in the art would not have been motivated to replace the straps with an alternative securing mechanism unless that mechanism provided some advantage or cured some deficiency of the straps. The action does not identify any such advantage or motivation for using something other than straps in swim goggles. Accordingly, a *prima facie* case of obviousness of claim 32 has not been established, and thus, the rejection must be withdrawn.

Moreover, there is no suggestion to combine or modify a prior art reference if the reference teaches away from making the specific combination of elements recited in a claim. *See Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360, 52 U.S.P.Q. 2d 1294, 1298 (Fed. Cir. 1999). Runckel teaches away from a strapless design because a user could not achieve the desired positioning for Runckel's eyepiece without the use of a head strap. In other words, the use of adhesive tape instead of the strap 24 would not be effective to pull the eyepieces 12, 12a

upwardly against the inner side of the supra-orbital border. Thus, a skilled person would not have been motivated to replace Runckel's head strap 24 with an alternative means for securing the eyepieces to the face of a user.

Accordingly, for the foregoing reasons, claim 32 is not rendered obvious by the Chiang '802 patent in view of Runckel and Banks and is allowable.

XI. Rejection of Claims 33-35, 37-38, and 44-45

Claims 33-35, 37-38, and 44-45 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by the '588 patent to Chiang (Chiang), and under 35 U.S.C. § 103(a) as allegedly being obvious from the '588 patent to Chiang. Applicants traverse this rejection and request that it be withdrawn.

Claims 33-35 and 38:

Claim 33 recites an eyepiece for swim goggles comprising, *inter alia*, a body comprising a transparent lens portion that includes a first, flat anterior lens that is positioned in front of the eye in an as worn orientation and at least a second, flat lens comprising flat and parallel opposed surfaces. The second lens reduces prismatic distortion of the lens portion and is connected to the anterior lens at an angle of approximately 124° to 164°.

The action concedes that the Chiang '588 patent does not specifically disclose the limitation of a side lens connected to an anterior lens at an angle of approximately 124° to 164°. (Although unclear from the drawings, it does not appear that the angle between side lens 121 and front lens 12 in Chiang falls within the claimed range.) Thus, the Chiang '588 patent does not anticipate claim 33.

The action further contends: "[I]t would have been obvious that the obtuse angle in Chiang's apparatus would include [the claimed range] since the claimed range falls within the general range of obtuse angles. The range claimed by the applicant does not appear to be critical to the functionality of the apparatus, and the applicant's specification even states that the angles could be less than or greater than the claimed range." Applicants disagree with this contention for the following reasons.

As disclosed in the present application, prismatic distortion of the side lens can be minimized by minimizing the angle between the line of sight through the side lens and the normal to the lens through which the line of sight extends. See page 17, line 6 -- page 18, line

23. The claimed range provides a functional advantage (or “criticality”) in that it minimizes the angle between the line of sight and the respective normal as the line of sight moves across the lens, and therefore minimizes prismatic distortion of the lens. There is no teaching or suggestion in the Chiang ‘588 patent for orienting the side lens 121 at such an angle relative to the anterior lens 12 so as to achieve this objective.

Regarding the action’s contention that the application discloses other possible angles, Applicants submit that an obviousness rejection cannot be based on teachings or information described in the application under examination. A legal conclusion of obviousness must be based on facts gleaned only from the prior art; hindsight analysis based on Applicants' disclosure is improper. MPEP § 2142; *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 U.S.P.Q. 929 (Fed. Cir. 1984) (holding that the PTO cannot use the patent application under examination as the basis for the motivation to combine references).

Moreover, the statement in the application that other angles could be used is provided to lend support for embodiments that include one or more aspects of the invention, but not necessarily the requirement of the side lens being at an angle between approximately 124 and 164 degrees. Furthermore, this statement does not undermine the fact the claimed range provides a functional advantage not taught or suggested by the applied prior art reference.

Claims 34, 35, and 38 depend from claim 33 and are allowable for the reasons given above in support of claim 33 and because each dependent claim sets forth an independently patentable combination of features.

For example, claim 35, in combination with claim 34, further recites that the second lens is a side lens that is connected to the anterior lens at an angle at which a line of sight extends perpendicularly with respect to the side lens whenever the eye is rotated temporally to a position at which the visual axis intersects a midpoint of the side lens. As discussed in the present application, by orienting the side lens at this position, there is little, if any prismatic distortion at the midpoint of the side lens and the distortion increases slightly as the line of sight deviates nasally or temporally from the midpoint. See page 18, lines 9-11. The Chiang ‘588 patent fails to provide any hint or suggestion for orienting the side lens 121 in the claimed manner so as to minimize prismatic distortion of the side lens 121.

Claim 37:

Claim 37 recites an eyepiece for swim goggles comprising, *inter alia*, a body comprising a transparent lens portion that includes a first, flat anterior lens that is positioned in front of the eye in an as worn orientation and at least a second, flat lens connected to the anterior lens at an obtuse angle and extending rearwardly therefrom. The second lens comprises a side lens that extends rearwardly and temporally from the anterior lens and is connected to the anterior lens at an angle of about 144°.

The action concedes that the Chiang '588 patent does not disclose the limitation of a side lens connected to an anterior lens at an angle of about 144°. Thus, the Chiang '588 patent does not anticipate claim 33.

The action further contends: "[I]t would have been obvious that the obtuse angle in Chiang's apparatus would include [the claimed angle] since the claimed angle falls within the general range of obtuse angles. The angle claimed by the applicant does not appear to be critical to the functionality of the apparatus, and the applicant's specification even states that the angles could be less than or greater than the claimed angle." Applicants disagree with this contention for the following reasons.

The claimed angle provides a functional advantage (a "criticality") of the goggles because as a result of the angle, the eyepiece can be positioned such that the temporal line of sight through the midpoint of the side lens will be substantially perpendicular to the side lens. This minimizes the amount of prismatic deviation across the side lens. See page 18 of the application. There is no teaching or suggestion in the Chiang '588 patent for orienting the side lens at such an angle to achieve this objective.

Claims 44-45:

Claims 44 and 45 depend from claim 40 and are allowable for the reasons given above in support of claim 40 and because each dependent claim sets forth an independently patentable combination of features.

XII. Rejection of Claims 36 and 39

Claims 36 and 39 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by, and under 35 U.S.C. § 103(a) as allegedly being obvious from, the '588 patent to Chiang in view of Banks. Applicants traverse this rejection and request that it be withdrawn.

Claims 36 and 39 depend indirectly from claim 33 and are allowable for the reasons given above in support of claim 33 and because each dependent claim sets forth an independently patentable combination of features.

Claim 36 further recites that the eyepiece body comprises a frame and the eyepiece includes a piece of double-sided tape having a first adhesive surface adhering to a posterior surface of the frame and a second adhesive surface for adhering to skin substantially surrounding the eye.

Claim 39, in combination with claim 38, further recites that the body comprises a frame portion, which has an adhesive layer that adhesively secures the eyepiece to the skin of the user.

In the rejection of claims 36 and 39, the action contends: "It would have been obvious . . . to modify Chiang's apparatus by utilizing a double-sided adhesive tape as a means to attach the goggles to the face of the user as taught by Banks since the use of adhesive tape would evenly distribute the force around the lens frame." Applicants disagree.

As conceded by the action, the primary object of the Chiang goggles is to distribute more evenly the force around the lens frame. If Chiang can already achieve this objective, then one skilled in the art would not have been motivated to seek Banks or to replace the straps with an alternative securing mechanism unless that mechanism provided some advantage or cured some deficiency of the straps. The action does not identify any such advantage or motivation for using something other than straps in swim goggles. Accordingly, a *prima facie* case of obviousness of claims 36 and 39 has not been established, and thus, the rejection must be withdrawn.

XIII. Rejection of Claim 41

Claim 41 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious from the '588 patent to Chiang in view of Runckel. Applicants traverse this rejection and request that it be withdrawn.

Claim 41 depends from claim 40 and is allowable for at least the reasons discussed above in support of claim 40 and because claim 41 sets forth an independently patentable combination of features.

XIV. Rejection of Claim 49

Claim 49 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious from the '588 patent to Chiang in view of U.S. Patent No. 6,006,367 to Webster (Webster). Applicants traverse this rejection and request that it be withdrawn.

Claim 49 depends from claim 48 and is allowable for at least the reasons discussed above in support of claim 48 and because claim 49 further recites that each side wall is symmetrical with respect to a line extending in the nasal-temporal direction.

In contrast to claim 49, in Webster, the side walls 60 are interrupted by top lenses 64 (see FIG. 2), and therefore the side walls are not symmetrical with respect to a line extending in the nasal-temporal direction. Hence, the proposed combination of Webster and the Chiang '588 patent does not yield the combination of features recited in claim 49.

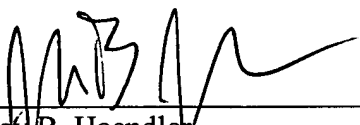
XV. Conclusion

The present application is in condition for allowance and such action is respectfully requested. If any further issues remain concerning this application, the Examiner is invited to call the undersigned to discuss such matters.

Respectfully submitted,

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